

ESTTA Tracking number: **ESTTA239727**

Filing date: **09/30/2008**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

## Notice of Opposition

Notice is hereby given that the following party opposes registration of the indicated application.

### Opposer Information

Name	Gen-Probe Incorporated		
Entity	Corporation	Citizenship	California
Address	10210 Genetic Center Drive San Diego, CA 92121 UNITED STATES		

Attorney information	Brian E. Banner Rothwell, Figg, Ernst, & Manbeck, P.C. 1425 K Street NW 8th Floor Washington, DC 20005 UNITED STATES PTO-TM-Email@rothwellfigg.com Phone:202-783-6040
----------------------	--

### Applicant Information

Application No	77267356	Publication date	09/02/2008
Opposition Filing Date	09/30/2008	Opposition Period Ends	10/02/2008
Applicant	Aptima, Inc. Suite 1400 12 Gill Street Woburn, MA 01801 UNITED STATES		

### Goods/Services Affected by Opposition

Class 009. First Use: 2001/12/31 First Use In Commerce: 2001/12/31 All goods and services in the class are opposed, namely: Computer hardware and software, for use with medical patient monitoring equipment, for receiving, processing, transmitting and displaying data for medical care providers; Computer software for controlling and managing patient medical information for medical care providers; Computer software for creating searchable databases of information and data for medical care providers; Computer software for the collection, editing, organizing, modifying, book marking, transmission, storage and sharing of data and information for medical care providers; Medical software for modeling, simulation, computer-based training, performance measurement, performance assessment, performance feedback, data capture, cognitive computing, data extraction and human language translation for medical care providers
--

### Grounds for Opposition

Priority and likelihood of confusion	Trademark Act section 2(d)
--------------------------------------	----------------------------

### Marks Cited by Opposer as Basis for Opposition

U.S. Registration No.	2884471	Application Date	10/20/2003
Registration Date	09/14/2004	Foreign Priority	NONE

		Date	
Word Mark	APTIMA		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 009. First use: First Use: 2000/02/28 First Use In Commerce: 2000/02/28 computer software for the organization and analysis of scientific and medical laboratory test data; computer software to control the operation of instrument systems for scientific and medical laboratory testing		

U.S. Registration No.	2432113	Application Date	11/13/1998
Registration Date	02/27/2001	Foreign Priority Date	NONE
Word Mark	APTIMA		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 001. First use: First Use: 2000/02/28 First Use In Commerce: 2000/02/28 Genetic probe assay kits comprising nucleic acids, reagents and buffers, all for biomedical research use Class 005. First use: First Use: 2000/02/28 First Use In Commerce: 2000/02/28 Genetic probe assay kits comprising nucleic acids, reagents and buffers, all for medical diagnostic use Class 010. First use: First Use: 2000/02/25 First Use In Commerce: 2000/02/25 Genetic probe assay kit accessories comprising vials, test tubes, and specimen handling devices, all for medical diagnostic use		

Attachments	75588396#TMSN.gif ( 1 page )( bytes ) 2599-175 Notice of Opposition.pdf ( 14 pages )(477433 bytes )
-------------	--

## Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/Brian E Banner/
Name	Brian E. Banner
Date	09/30/2008

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In the Matter of Application  
Serial No. 77/267,356 in the  
Official Gazette dated September 2, 2008  
on Page TM 427

Gen-Probe Incorporated	:	
	:	
Opposer,	:	
	:	
v.	:	Opposition No. _____
	:	
Aptima, Inc.	:	
	:	
Applicant.	:	
	:	

**NOTICE OF OPPOSITION**

Gen-Probe Incorporated, a Delaware corporation, (hereinafter “Gen-Probe”) with an address at 10210 Genetic Center Drive, San Diego, California, believes that it will be damaged by registration of the mark “APTIMA” for “computer hardware and software, for use with medical patient monitoring equipment, for receiving, processing, transmitting and displaying data for medical care providers; computer software for controlling and managing patient medical information for medical care providers; computer software for creating searchable databases of information and data for medical care providers; computer software for the collection, editing, organizing, modifying, book marking, transmission, storage and sharing of data and information for medical care providers; medical software for modeling, simulation, computer-based training, performance measurement, performance assessment, performance feedback, data capture, cognitive computing, data extraction and human language translation for medical care providers,” (hereinafter “Applicant’s Mark”) in International Class 9 as set forth in Application Serial No. 77/267,356, filed on August 29, 2007, and published on September 2, 2008 (hereinafter the “Application”), owned by Aptima, Inc. with an

address at 12 Gill Street, Suite 1400, Woburn, MA 01801 (hereinafter the "Applicant"), and hereby opposes the same. As grounds for this opposition, it is alleged that:

1. Since long prior to the date of first use alleged in the application for Applicant's Mark, Gen-Probe has extensively used and promoted the mark "APTIMA," (hereinafter the "Gen-Probe Mark") for computer software for the organization and analysis of scientific and medical laboratory test data; computer software to control the operation of instrument systems for scientific and medical laboratory testing. Such goods are distributed to and used by entities and individuals with knowledge of the medical field, including medical care providers.

2. Gen-Probe is the owner and user of the U.S. Registration No. 2,884,471 registered on September 14, 2004 for APTIMA for computer software for the organization and analysis of scientific and medical laboratory test data; computer software to control the operation of instrument systems for scientific and medical laboratory testing in Class 9. Gen-Probe is also the owner and user of the U.S. Registration No. 2,432,113 registered on February 27, 2001 for APTIMA for genetic probe assay kits comprising nucleic acids, reagents and buffers, all for biomedical research use, in Class 1; genetic probe assay kits comprising nucleic acids, reagents and buffers, all for medical diagnostic use in Class 5, and genetic probe assay kit accessories comprising vials, test tubes, and specimen handling devices, all for medical diagnostic use in Class 10.

3. The above registrations (collectively the "Gen-Probe Registrations") are valid and subsisting. Status and title copies of the registrations are attached as **Exhibit A and B** to the Notice of Opposition.

4. Gen-Probe has prominently and extensively used and promoted the Gen-Probe Mark and Gen-Probe Registrations.

5. By virtue of the uncompromising and prestigious quality of goods and related services sold, advertised and promoted under the Gen-Probe Mark and by virtue of the extensive sales, promotion and advertising of such high quality goods and services, the Gen-Probe Mark and Gen-Probe Registrations have become well-known and have acquired extensive recognition and strength throughout the United States.

6. Applicant has no connection with Gen-Probe and no permission or license was given by Gen-Probe to Applicant to use the APTIMA mark.

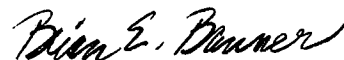
7. Gen-Probe's use of the Gen-Probe Mark and Gen-Probe Registrations is such that members of the public will view Applicant's Mark with knowledge of the Gen-Probe Mark and Gen-Probe Registrations and mistakenly assume that Applicant's Mark emanates from Gen-Probe and/or is authorized or approved by Gen-Probe due to its similarity to the Gen-Probe Mark and Gen-Probe Registrations.

8. Applicant's Mark so closely resembles the Gen-Probe Mark and Gen-Probe Registrations that its use, in connection with software sold to and used by medical care providers and others, is likely to cause confusion, or to cause mistake or deceive, in violation of Section 2(d) of the Trademark Act of 1946, 15 U.S.C. § 1052 (d). Purchasers likely will assume that Gen-Probe is somehow affiliated with, licenses, or endorses, use of Applicant's Mark when Gen-Probe is not connected in any way with Applicant or the intended use of Applicant's Mark.

9. The registration of Applicant's Mark would be inconsistent with Gen-Probe's rights in the Gen-Probe Registrations and Gen-Probe's rights at common law and will be damaging to Gen-Probe.

WHEREFORE, Gen-Probe prays that this opposition be sustained and registration on the Application be refused.

Respectfully submitted,  
Gen-Probe Incorporated

By:   
G. Franklin Rothwell  
Anne M. Sterba  
Brian E. Banner  
Attorneys for Opposer  
Rothwell, Figg, Ernst & Manbeck P.C.  
1425 K St., N.W.; Suite 800  
Washington, DC 20005  
202-783-6040

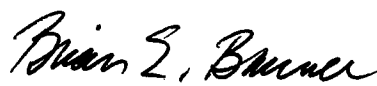
Date: September 30, 2008  
1527402

**CERTIFICATE OF SERVICE**

This is to certify that a copy of the foregoing NOTICE OF OPPOSITION and Exhibits has been served by First Class mail, postage prepaid, to

John Brooks, J.D.  
Intellectual Property Counsel  
Aptima, Inc.  
12 Gill Street, Suite 1400  
Woburn, MA 01801 USA

On this 30<sup>th</sup> day of September, 2008.

  
Brian E. Banner

**Thank you for your request. Here are the latest results from the TARR web server.**

**This page was generated by the TARR system on 2008-09-29 10:53:42 ET**

**Serial Number:** 75588396 Assignment Information      Trademark Document Retrieval

**Registration Number:** 2432113

**Mark (words only):** APTIMA

**Standard Character claim:** No

**Current Status:** Section 8 and 15 affidavits have been accepted and acknowledged.

**Date of Status:** 2007-09-12

**Filing Date:** 1998-11-13

**Transformed into a National Application:** No

**Registration Date:** 2001-02-27

**Register:** Principal

**Law Office Assigned:** LAW OFFICE 105

**If you are the applicant or applicant's attorney and have questions about this file, please contact the Trademark Assistance Center at TrademarkAssistanceCenter@uspto.gov**

**Current Location:** 830 -Post Registration

**Date In Location:** 2007-09-12

---

#### **LAST APPLICANT(S)/OWNER(S) OF RECORD**

---

1. Gen-Probe Incorporated

**Address:**

Gen-Probe Incorporated  
10210 Genetic Center Drive  
San Diego, CA 92121  
United States

**Legal Entity Type:** Corporation

**State or Country of Incorporation:** Delaware

---

#### **GOODS AND/OR SERVICES**

---

**International Class:** 001

**Class Status:** Active

***Gen-Probe Incorporated v. Aptima, Inc.  
Gen-Probe's Exhibit A***

**Section 8 & 15 accepted and acknowledged**

**Title:** Gen-Probe      Page 1 of 5

<http://tarr.uspto.gov/tarr?regser=registration&entry=2%2C432702C115&action=lookup> ... 7/27/2008

Genetic probe assay kits comprising nucleic acids, reagents and buffers, all for biomedical research use

**Basis:** 1(a)

**First Use Date:** 2000-02-28

**First Use in Commerce Date:** 2000-02-28

**International Class:** 005

**Class Status:** Active

Genetic probe assay kits comprising nucleic acids, reagents and buffers, all for medical diagnostic use

**Basis:** 1(a)

**First Use Date:** 2000-02-28

**First Use in Commerce Date:** 2000-02-28

**International Class:** 010

**Class Status:** Active

Genetic probe assay kit accessories comprising vials, test tubes, and specimen handling devices, all for medical diagnostic use

**Basis:** 1(a)

**First Use Date:** 2000-02-25

**First Use in Commerce Date:** 2000-02-25

---

#### ADDITIONAL INFORMATION

---

(NOT AVAILABLE)

---

#### MADRID PROTOCOL INFORMATION

---

(NOT AVAILABLE)

---

#### PROSECUTION HISTORY

---

**NOTE: To view any document referenced below, click on the link to "Trademark Document Retrieval" shown near the top of this page.**

2007-10-17 - Review Of Correspondence Complete

2007-09-12 - Section 8 (6-year) accepted & Section 15 acknowledged

2007-08-30 - PAPER RECEIVED

2007-05-08 - TEAS Change Of Correspondence Received

2007-02-22 - Case File In TIGRS

2007-02-15 - TEAS Section 8 & 15 Received

2004-12-29 - TEAS Change Of Correspondence Received

2004-05-18 - TEAS Change Of Correspondence Received

***Gen-Probe Incorporated v. Aptima, Inc.***  
**Gen-Probe's Exhibit A**

**Section 8 & 15 accepted and acknowledged**  
**Title: Gen-Probe**      Page 2 of 5



2003-05-15 - TEAS Change Of Correspondence Received  
2001-02-27 - Registered - Principal Register  
2000-09-19 - Allowed for Registration - Principal Register (SOU accepted)  
2000-09-15 - Assigned To Examiner  
2000-07-17 - Assigned To Examiner  
2000-07-14 - Statement of use processing complete  
2000-05-23 - Amendment to Use filed  
1999-12-07 - Notice of allowance - mailed  
1999-09-14 - Published for opposition  
1999-08-13 - Notice of publication  
1999-06-03 - Approved for Pub - Principal Register (Initial exam)  
1999-06-02 - Assigned To Examiner

---

**ATTORNEY/CORRESPONDENT INFORMATION**

---

**Attorney of Record**

G. FRANKLIN ROTHWELL

**Correspondent**

G. FRANKLIN ROTHWELL  
ROTHWELL, FIGG, ERNST & MANBECK, P.C.  
1425 K STREET, NW  
SUITE 800  
WASHINGTON, DC 20005  
Phone Number: 202-783-6040  
Fax Number: 202-783-6031

***Gen-Probe Incorporated v. Aptima, Inc.***  
**Gen-Probe's Exhibit A**

**Section 8 & 15 accepted and acknowledged**  
**Title: Gen-Probe      Page 3 of 5**



United States Patent and Trademark Office

[Home](#) | [Site Index](#) | [Search](#) | [Guides](#) | [Contacts](#) | [eBusiness](#) | [eBiz alerts](#) | [News](#) | [Help](#)



**Assignments on the Web > Trademark Query**

**No assignment has been recorded at the USPTO**

**For Serial Number: 75588396**

If you have any comments or questions concerning the data displayed, contact PRD / Assignments at 571-272-3350. v.2.0.1  
Web interface last modified: April 20, 2007 v.2.0.1

[| .HOME](#) | [INDEX](#) | [SEARCH](#) | [eBUSINESS](#) | [CONTACT US](#) | [PRIVACY STATEMENT](#)

***Gen-Probe Incorporated v. Aptima, Inc.***  
**Gen-Probe's Exhibit A**

**Section 8 & 15 accepted and acknowledged**  
**Title: Gen-Probe**      **Page 4 of 5**

Int. Cls.: 1, 5, and 10

Prior U.S. Cls.: 1, 5, 6, 10, 18, 26, 39, 44, 46,  
51, and 52

Reg. No. 2,432,113

**United States Patent and Trademark Office**

Registered Feb. 27, 2001

**TRADEMARK  
PRINCIPAL REGISTER**

**APTIMA**

GEN-PROBE INCORPORATED (DELAWARE COR-  
PORATION)  
10210 GENETIC CENTER DRIVE  
SAN DIEGO, CA 92121

FOR: GENETIC PROBE ASSAY KITS COM-  
PRISING NUCLEIC ACIDS, REAGENTS AND BUFF-  
ERS, ALL FOR BIOMEDICAL RESEARCH USE, IN  
CLASS 1 (U.S. CLS. 1, 5, 6, 10, 26 AND 46).

FIRST USE 2-28-2000; IN COMMERCE 2-28-2000.

FOR: GENETIC PROBE ASSAY KITS COM-  
PRISING NUCLEIC ACIDS, REAGENTS AND BUFF-

ERS, ALL FOR MEDICAL DIAGNOSTIC USE, IN  
CLASS 5 (U.S. CLS. 6, 18, 44, 46, 51 AND 52).

FIRST USE 2-28-2000; IN COMMERCE 2-28-2000.

FOR: GENETIC PROBE ASSAY KIT ACCES-  
SORIES COMPRISING VIALS, TEST TUBES, AND  
SPECIMEN HANDLING DEVICES, ALL FOR MED-  
ICAL DIAGNOSTIC USE, IN CLASS 10 (U.S. CLS.  
26, 39 AND 44).

FIRST USE 2-25-2000; IN COMMERCE 2-25-2000.

SN 75-588,396, FILED 11-13-1998.

BRIAN RUPP, EXAMINING ATTORNEY.

*Gen-Probe Incorporated v. Aptima, Inc.*  
Gen-Probe's Exhibit A

Section 8 & 15 accepted and acknowledged  
Title: Gen-Probe Page 5 of 5

**Thank you for your request. Here are the latest results from the TARR web server.**

**This page was generated by the TARR system on 2008-09-29 11:05:40 ET**

**Serial Number:** 78315970 [Assignment Information](#) [Trademark Document Retrieval](#)

**Registration Number:** 2884471

**Mark (words only):** APTIMA

**Standard Character claim:** No

**Current Status:** Registered.

**Date of Status:** 2004-09-14

**Filing Date:** 2003-10-20

**Transformed into a National Application:** No

**Registration Date:** 2004-09-14

**Register:** Principal

**Law Office Assigned:** LAW OFFICE 108

**If you are the applicant or applicant's attorney and have questions about this file, please contact the Trademark Assistance Center at [TrademarkAssistanceCenter@uspto.gov](mailto:TrademarkAssistanceCenter@uspto.gov)**

**Current Location:** 900 -File Repository (Franconia)

**Date In Location:** 2004-09-21

---

#### LAST APPLICANT(S)/OWNER(S) OF RECORD

---

1. Gen-Probe Incorporated

**Address:**

Gen-Probe Incorporated  
10210 Genetic Center Drive  
San Diego, CA 92121  
United States

**Legal Entity Type:** Corporation

**State or Country of Incorporation:** Delaware

---

#### GOODS AND/OR SERVICES

---

**International Class:** 009

**Class Status:** Active

***Gen-Probe Incorporated v. Aptima, Inc.***  
**Gen-Probe's Exhibit B**

**Registered**

**Title:** Gen-Probe

Page 1 of 5

<http://tarr.uspto.gov/tarr?regser=registration&entry=2%2C884%2C471+&action=Request...> 9/29/2008

computer software for the organization and analysis of scientific and medical laboratory test data;  
computer software to control the operation of instrument systems for scientific and medical laboratory testing

**Basis:** 1(a)

**First Use Date:** 2000-02-28

**First Use in Commerce Date:** 2000-02-28

---

#### ADDITIONAL INFORMATION

---

(NOT AVAILABLE)

---

#### MADRID PROTOCOL INFORMATION

---

(NOT AVAILABLE)

---

#### PROSECUTION HISTORY

---

**NOTE: To view any document referenced below, click on the link to "Trademark Document Retrieval" shown near the top of this page.**

2007-05-08 - TEAS Change Of Correspondence Received

2004-12-29 - TEAS Change Of Correspondence Received

2004-09-14 - Registered - Principal Register

2004-06-22 - Published for opposition

2004-06-07 - PAPER RECEIVED

2004-06-02 - Notice of publication

2004-05-18 - TEAS Change Of Correspondence Received

2004-04-12 - Approved for Pub - Principal Register (Initial exam)

2004-04-12 - Assigned To Examiner

2003-11-04 - New Application Entered In Tram

---

#### ATTORNEY/CORRESPONDENT INFORMATION

---

**Attorney of Record**

F. T. ALEXANDRA MAHANEY

**Correspondent**

G. Franklin Rothwell, Esq.  
Rothwell, Figg, Ernst & Manbeck, P.C.

*Gen-Probe Incorporated v. Aptima, Inc.*  
**Gen-Probe's Exhibit B**

**Registered**

**Title: Gen-Probe**

Page 2 of 5

Suite 800  
1425 K Street, NW  
Washington DC 20005  
Phone Number: 202-783-6040  
Fax Number: 202-783-6031

---

***Gen-Probe Incorporated v. Aptima, Inc.***  
**Gen-Probe's Exhibit B**

**Registered**  
**Title: Gen-Probe**

Page 3 of 5



United States Patent and Trademark Office

[Home](#) | [Site Index](#) | [Search](#) | [Guides](#) | [Contacts](#) | [eBusiness](#) | [eBiz alerts](#) | [News](#) | [Help](#)



**Assignments on the Web > Trademark Query**

**No assignment has been recorded at the USPTO**

**For Serial Number: 78315970**

If you have any comments or questions concerning the data displayed, contact PRD / Assignments at 571-272-3350. v.2.0.1  
Web interface last modified: April 20, 2007 v.2.0.1

[| .HOME](#) | [INDEX](#) | [SEARCH](#) | [eBUSINESS](#) | [CONTACT US](#) | [PRIVACY STATEMENT](#)

***Gen-Probe Incorporated v. Aptima, Inc.***  
**Gen-Probe's Exhibit B**

**Registered**  
**Title: Gen-Probe**

Page 4 of 5

**Int. Cl.: 9**

**Prior U.S. Cls.: 21, 23, 26, 36 and 38**

**Reg. No. 2,884,471**

**United States Patent and Trademark Office**

**Registered Sep. 14, 2004**

**TRADEMARK  
PRINCIPAL REGISTER**

**APTIMA**

GEN-PROBE INCORPORATED (DELAWARE  
CORPORATION)  
10210 GENETIC CENTER DRIVE  
SAN DIEGO, CA 92121

FOR: COMPUTER SOFTWARE FOR THE ORGA-  
NIZATION AND ANALYSIS OF SCIENTIFIC AND  
MEDICAL LABORATORY TEST DATA; COMPU-  
TER SOFTWARE TO CONTROL THE OPERATION  
OF INSTRUMENT SYSTEMS FOR SCIENTIFIC

AND MEDICAL LABORATORY TESTING, IN  
CLASS 9 (U.S. CLS. 21, 23, 26, 36 AND 38).

FIRST USE 2-28-2000; IN COMMERCE 2-28-2000.

SER. NO. 78-315,970, FILED 10-20-2003.

MIDGE BUTLER, EXAMINING ATTORNEY

*Gen-Probe Incorporated v. Aptima, Inc.*  
**Gen-Probe's Exhibit B**

**Registered**  
**Title: Gen-Probe**

Page 5 of 5